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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
1601457-0008

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
09/898,310	07/03/2001

First Named Inventor
Teng Pin Poo

Art Unit	Examiner
2137	Shewaye Gelagay

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

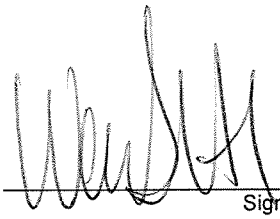
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 36,828

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Warren S. Heit
Typed or printed name

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January 10, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

ATTACHMENT TO THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the Office Action of July 10, 2007, the Examiner rejected claims 1-27. Applicants respectfully submit that claims 1-27 are allowable over the cited art.

Rejections – 35 U.S.C. § 103

Claims 1, 11 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al., U.S. Patent No. 6,671,808 (hereafter Abbott) in view of Vanzini et al., U.S. Patent No. 7,036,738 (hereafter Vanzini). The Applicants respectfully traverse.

Abbott is not a mass storage device. Instead, Abbott is a security device in which a small amount of authentication data is stored to address security issues including preventing piracy and avoiding the need to remember a number of different passwords. For example, in the Background of the Invention, Abbott describes the problems confronted by the inventors:

> First, the growing use of computers has resulted in extensive unauthorized use and copying of computer software, costing software developers substantial revenue. (col. 1, lines 41-43)
>
> ****
>
> Internet commerce raises other challenges. Users seeking to purchase goods or services using the Internet must be assured that their credit card numbers and the like are safe from compromise. At the same time, vendors must be assured that services and goods are delivered only to those who have paid for them. In many cases, these goals are accomplished with the use of passwords. However, as Internet commerce becomes more commonplace, customers are finding themselves in a position where they must either decide to use a small number of passwords for all transactions, or face the daunting task of remembering multiple passwords. Using a small number of passwords for all transactions inherently compromises security, since the disclosure of any of the passwords may lead to a disclosure of the others. Even the use of a large number of passwords can lead to compromised security. Because customers commonly forget their password, many Internet vendors provide an option whereby the user can be reminded of their password by providing other personal information such as their birthplace, mother's maiden name, and/or social security number. This feature, while often necessary to promote Internet commerce, severely compromises the password by relying on "secret" information that is in fact, publicly available. (emphasis supplied, col. 2, lines 36-59)

Abbott proposes a "personal key" to solve these security issues. Throughout the specification of Abbott, the term "personal key" is used almost exclusively. The personal key of Abbott is designed to store the minimal amount of data necessary to address these security issues. In the Summary of the Invention, Abbott describes:

> The personal key provides for the storage and management of digital certificates, allowing the user to store all of his digital certificates in one media that is portable from platform to platform. The personal key provides for the generation, storage, and management of many passwords, providing additional security and relieving the user from the task of remembering multiple passwords. The personal key provides a means to store cookies and other Java-implemented software programs, allowing the user to accept cookies in a removable and secure form-factor. These features are especially useful when the present invention is used in a virtual private network (VPN).

Thus, Abbott teaches a personal key on which a minimal amount of information can be stored and used to unlock different resources available via computer. Abbott is in essence a sophisticated dongle, which Abbott describes in the Background of the Invention. See Abbott at col. 1, lines 49-62.

A personal key or a dongle used to unlock computer resources, even one such as the personal key of Abbott on which a small amount of security information can be stored, does not render obvious a mass storage device on which more than 8M of user data can be stored and protected via biometric means. The fact that a storage device in the form of, e.g. a PCMCIA card, was publicly available at the time of the invention having a storage capacity in excess of 8M that was protected by a smartcard and/or a keyed-in passcode, such as that in Vanzini, does not change this conclusion. A skilled artisan would not be taught or motivated to modify the personal key of Abbott to store 8M of user data and protect such data using a biometric sensor. Such modifications would have been inconsistent with the purpose and intent of the personal key of Abbott – i.e., unlocking resources available via computers.

None of the other pieces of art cited by the Examiner, including Foster (U.S. Pub. No. 2002/0145507), Price-Francis (U.S. Patent 5,815,252), Polansky (U.S. Pub. No. 2001/0045458), Willins et al. (U.S. Patent No. 6,990,587) and/or Terasaki et al., U.S. Publication No. 2001/0004326, cures this deficiency. Therefore, no combination of any two or more pieces of the cited art teaches all the subject matter in claims 1, 11, or 17. Consequently, claims 1, 11, and 17 and all claims dependent therefrom (which are all the other pending claims) are patentable over all the cited art.